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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,697	12/04/2003	Ted A. Barnes	PGI 02910 PTUS	8662

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EXAMINER
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VANTERPOOL, LESTER L

ART UNIT	PAPER NUMBER
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3782

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/727,697

Applicant(s)

BARNES, TED A.

Examiner

Lester L. Vanterpool

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 16, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 & 15 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>January 16, 2007</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 15 of copending Application No. 10-778,385 in view of Pennig (U.S. Patent Number 5827282).

Copending application teaches body (See Figure 4); a pair of mounting holes (20 & 22) in the body (14) (See Figure 4); the mounting holes (20 & 22) aligned with portals (112 & 114) in the control bracket (106) (See Figure 4); a radial relief (35) located

Art Unit: 3782

between the parallel mounting holes (20 & 2) (See Figure 4); a threaded accessory hole (28) (See Figure 4); a pair of hollow standoffs (36 & 38) located between the mounting holes (20 & 22) and bolt portals (112 & 114) in the control bracket (106); and, where the body (14) is engageable with the control bracket (106) (See Figure 4).

However, copending application does not disclose the substantially parallel mounting holes.

Pennig teaches the elongated substantially parallel mounting holes (See internal wall of (3) in Figures 1 & 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make substantially parallel mounting holes as taught by Pennig with the vehicle accessory mount of copending application in order to accommodate various bolts and screws.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 & 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahoney et al., (U.S. Patent Number 6957755 B2).

Art Unit: 3782

Mahoney et al., discloses the body (100) (See Figure 1);  
the pair of substantially parallel mounting holes (18) in the body (100) (See Figures 1 – 3);  
the mounting holes (18, 64.2 & 64.3) aligned with portals (62.2 & 62.3) in the control bracket (62) (See Figures 6 & 7);  
the radial relief (67) located between the parallel mounting holes (18, 64.2 & 64.3) (See Figures 6 & 7);  
the threaded accessory hole (65) (See Figure 6); and,  
wherein the body (100) is engagable with the control bracket (60) (See Figure 7).

Regarding claim 3, Mahoney et al., discloses the body (100) is generally rectangular (See Figures 1 – 10).

6. Claims 1, 4 – 7, 9 – 12 & 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Pennig (U.S. Patent Number 5827282).

Pennig is capable of being a vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body; and,  
discloses the body (3) (See Figure 1);  
the pair of substantially parallel mounting holes (See internal wall of (3) in Figures 1 & 2) in the body (3);  
the mounting holes (See internal wall of (3) in Figure 1) aligned with portals in the control bracket (2);

Art Unit: 3782

the radial relief (5) located between the parallel mounting holes (See internal side of (3) in Figures 1 & 2);

the threaded accessory hole (15) (See Figures 2 & 2A); and,

wherein the body (3) is engageable with the control bracket (2) (See Figures 3 & 4).

Regarding claim 4, Pennig discloses the threaded accessory (15) is located between the mounting holes (See internal side of (3) in Figure 1).

Regarding claim 5, Pennig discloses the threaded accessory hole (15) (See Figure 1) is located in substantially perpendicular relationship to the mounting holes (See internal wall of (3) in Figure 1).

Regarding claim 6, Pennig discloses the ball stud (9) attached to the threaded accessory hole (15) (See Figure 1).

Regarding claim 7, Pennig discloses the body (3) (See Figure 1);  
the pair of parallel mounting holes (See internal wall of (3) in Figure 1) in the body (3) (See Figures 1 & 2); and,  
the ball stud (9) attached to the body (See Figure 1).

Art Unit: 3782

Regarding claim 9, Pennig discloses the body (3) is generally rectangular (See inner wall perimeter having a generally rectangular shape in Figures 1 & 2).

Regarding claim 10, Pennig discloses the radial relief (5) located between the parallel mounting holes (See internal wall of (3) in Figures 1 & 2).

Regarding claim 11, Pennig discloses the threaded accessory hole (15) (See Figure 2 & 2A) is located between the mounting holes (See internal wall of (3) in Figures 1 & 2).

Regarding claim 12, Pennig discloses the threaded accessory hole (15) (See Figure 2 & 2A) is located in substantially perpendicular relationship to the mounting holes (See internal wall of (3) in Figures 1 & 2).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 8, 13 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennig (U.S. Patent Number 5827282).

Art Unit: 3782

Pennig is capable of being a vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body; and, discloses the cylinder portion (See internal wall of (3) in See Figures 1 & 2). However, Pennig does not disclose the countersink portion that is larger in diameter than the cylinder portion.

It would have been an obvious matter of design choice to make the countersink portion that is larger in diameter than the cylinder portion, since applicant has not disclosed that the countersink portion that is larger in diameter than the cylinder portion solves any stated problem or is for any particular purpose and it appears that he invention would perform equally well with a flush portion in the cylinder portion.

Regarding claim 8, Pennig is capable of being a vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body; and,

discloses the body (3) (See Figure 1);

the pair of substantially parallel mounting holes (See internal wall of (3) in Figures 1 & 2) in the body (3);

the mounting holes (See internal wall of (3) in Figures 1 & 2) aligned with portals (See wall of (2) in Figures 1 & 2) in the control bracket (2) (See Figure 2); and,

the threaded accessory hole (15) (See Figures 2 & 2A).

However, Pennig does not disclose the pair of hollow standoff located between the mounting holes and bolt portals in the control bracket.



Art Unit: 3782

It would have been an obvious matter of design choice to make the pair of hollow standoff located between the mounting holes and bolt portals in the control bracket, since applicant has not disclosed that the pair of hollow standoff located between the mounting holes and bolt portals in the control bracket solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with no hollow standoff.

Regarding claim 13, Pennig discloses the cylinder portion (See internal wall of (3) in See Figures 1 & 2).

However, Pennig does not disclose the countersink portion that is larger in diameter than the cylinder portion.

It would have been an obvious matter of design choice to make the countersink portion that is larger in diameter than the cylinder portion, since applicant has not disclosed that the countersink portion that is larger in diameter than the cylinder portion solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a flush portion in the cylinder portion.

Regarding claim 15, Pennig is capable of being a vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body; and,

discloses the body (3) (See Figures 1 & 2);

the pair of substantially parallel mounting holes (See internal wall of (3) in Figures 1 & 2) in the body (3); and;

the mounting holes (See internal wall of (3) in Figures 1 & 2) aligned with portals (See holes of (2) in Figures 1 & 2) in the control bracket (2);

the ball stud (9) attached to the body (3) (See Figures 1 & 2).

However, Pennig does not disclose the pair of hollow standoff located between the mounting holes and the portals.

It would have been an obvious matter of design choice to make the pair of hollow standoff located between the mounting holes and portals, since applicant has not disclosed that the pair of hollow standoff located between the mounting holes and portals solves any stated problem or is for any particular purpose and it appears that he invention would perform equally well without hollow standoff.

#### ***Allowable Subject Matter***

9. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1 – 15 have been considered but are moot in view of the new ground(s) of rejection.

Furthermore, the clamp couplings are capable and adaptable of being attached to a control bracket of a handle-barred vehicle throttle or clutch control body as a vehicle accessory mount.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Savant (U.S. Patent Number 6021936) and Hancock et al., (U.S. Patent Number 6484913 B1).

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lester L. Vanterpool whose telephone number is 571-272-8028. The examiner can normally be reached on Monday - Friday (8:30 - 5:00) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
LLV

  
NATHAN J. NEWHOUSE  
SUPERVISORY PATENT EXAMINER